

REMARKS

Applicant has carefully reviewed the Application in light of the Office Action mailed August 19, 2008. At the time of the Office Action, Claims 1-8, 10-16, and 18-23 were pending in the Application and they stand rejected. Applicant amends Independent Claim 1 and cancels Claim 2 without prejudice and disclaimer. The amendments [and cancellation] to the claims are not the result of any prior art reference and, thus, do not narrow the scope of any claims. Furthermore, the amendments are not related to patentability issues and only further clarify subject matter already present. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

35 USC §102 Rejection

Claims 1-5, 7-12 and 14-23 stand rejected under 35 U.S.C § 102 as being anticipated by U.S. Publication No. 2002/0129140 issued to Peled (hereinafter "*Peled*").

*Independent Claim 1 is Patentable over Peled*

Applicant respectfully reminds the Examiner that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.<sup>1</sup> In addition, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claims" and "[t]he elements must be arranged as required by the claim."<sup>2</sup> In regard to inherency of a reference, "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic."<sup>3</sup> Thus, in relying upon the theory of inherency, an Examiner must provide a basis in fact and/or technical reasoning to support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.<sup>4</sup>

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<sup>1</sup> *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131.

<sup>2</sup> *Richardson v. Suzuki Motor Co.*, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 USPQ 2d 1566 (Fed. Cir. 1990); MPEP §2131 (*emphasis added*).

<sup>3</sup> MPEP §2112 (citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ 2d 1955, 1957 (Fed. Cir. 1993) (*emphasis in original*)).

<sup>4</sup> MPEP §2112 (citing *Ex Parte Levy*, 17 USPQ 2d 1461, 1464 (Bd. Pat. at App. and Inter. 1990) (*emphasis in original*)).

Independent Claim 1, as amended, recites:

A computer-implemented method comprising:

maintaining a plurality of stored signatures in a data storage device, each signature being associated with one of a plurality of registered documents;

intercepting packets being transmitted over a network;

reassembling the packets into an intercepted document;

calculating a set of signatures associated with the intercepted document;

and

comparing the set of signatures associated with the intercepted document with the plurality of stored signatures to determine if the intercepted document contains content associated with a registered document, wherein each registered document is associated with a user that requested registration of the document.

No reference of record, including *Peled*, offers an architecture in which “...each signature being associated with one of a plurality of registered documents...***each registered document is associated with a user that requested registration of the document.***” For this limitation, the Examiner has cited the following portions of *Peled*:

[0011] The present invention seeks to provide a novel method and system for the mitigation of illegal and unauthorized transport of digital content, without otherwise interfering with rightful usage and the privacy of the users.

[0019] a database of at least one preobtained description of content whose movements it is desired to monitor, and

Rhetorically: Where is ***the user*** in either of these passages? Furthermore, at a more granular level, where is there a disclosure about each registered document being associated with a specific user that ***requested*** registration of the document? Specifically, Independent

Claim 1 is outlining that each registered document has a counterpart; namely, the user that requested registration of that specific document. In contrast, there is no user specified in Peled: much less one that requested the registration, much less one that is associated with each individual document, as is outlined by Independent Claim 1.

It is unclear as to how the architecture of *Peled* is configured. Perhaps a computer or an algorithm is fed key words to monitor, and signatures are released or discharged from that configuration. However, what is abundantly clear is that: In no event does *Peled* disclose a user requesting registration of the document and that document having an association with that specific user that requested the registration. Applicant has taken the time to review *Peled* in its entirety and finds nothing that would be relevant to this feature of Independent Claim 1.

Such a feature could be important in various implementations of such a system. For example, in using such an association [between the document and the exact user that requested the registration], a person could readily see **who** requested the registration. In a non-limiting example, consider a case where there would be some corporate hierarchy involved such that a supervisor (e.g., a SPE) could see that the registration was requested by a subordinate (e.g., a Junior Examiner). In this sense, an end user is informed about who requested the registration and, perhaps, this information could empower that end user to make a more intelligent decision about adhering to (or ignoring) this registration.

For at least these reasons, each of the Independent Claims are allowable over the cited reference. Additionally, the corresponding dependent claims from these Independent Claims are also patentably distinct for analogous reasons.

It should also be noted that nothing in *Peled* discloses how packets would be ***reassembled into an intercepted document***, as is outlined in Independent Claim 1. A “buffered batch of packets” from *Peled* does not provide the requisite disclosure for such a reassembly feature. In contrast to Independent Claim 1, *Peled* describes working with chunks of files, but the *Peled* architecture reassembles nothing. These important limitations are provided for in Independent Claims 1, 8, and 16 but no reference of record includes such

elements. Applicant has reviewed *Peled* in its entirety and finds nothing that would be relevant to such operations.

35 U.S.C § 103(a) Rejections

Claim 6 stands rejected under 35 U.S.C §103(a) as being unpatentable over *Peled* in view of U.S. Publication No. 2003/0084300 issued to Koike (hereinafter "*Koike*").

This rejection is now moot in light of the preceding §102 analysis. Specifically, nothing in *Peled* (or in any other reference) provides the user feature, which was evaluated extensively above.

For at least these reasons, all of the pending claims have been shown to be allowable as they are patentable over the references of record. Notice to this effect is respectfully requested in the form of a full allowance of these claims.

CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for all other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

This Response is being filed concurrently herewith a Petition for a Two-Month Extension of Time and the appropriate large entity fee of \$490 is being paid concurrently herewith via Electronic Filing System (EFS) by way of credit card.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact Thomas J. Frame at (214) 823-1241.

Respectfully submitted,

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/s/ Thomas J. Frame

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Date: December 23, 2008

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